

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JENNIFER WEST and BRENDA MANN

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Appeal 2008-2053  
Application 09/935,168  
Technology Center 1600

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Mailed: August 6, 2008

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Before DALE M. SHAW, *Chief Appeals Administrator*.  
SHAW, *Chief Appeals Administrator*.

ORDER REMANDING TO EXAMINER

FINDINGS OF FACT

On April 20, 2006, the Examiner mailed a Final Office Action,  
rejecting claims 1-5, 7-9, and 24-35. The grounds of rejection in the Non-  
Final Rejection are:

Claims 24-35 are rejected under 35 U.S.C. § 112, first paragraph, as not enabled by the disclosure.

Claims 24-35 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Claims 24, 28, 31 and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,162,430.

Claims 1-2, 4, 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of Dinbergs et al.

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of Dinbergs et al. and further in view of Scott-Burden et al.

Claims 5, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of Dinbergs et al. and further in view of U.S. Pat No. 5,935,849.

Claims 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of Dinbergs et al. and further in view of WO 94/23740 or WO 96/276657.

Claims 24-27 and 32-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of U.S. Patent No. 5,935,849.

Claims 27 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of U.S. Patent No. 5,935,849 further in view of Dinbergs.

Claims 24 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of Scott-Burden et al.

Claims 24 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,162,430 in view of WO 94/23740 or WO 96/276657.

On December 19, 2006, the Appellant filed an Appeal Brief, which states:

Claims 1-2, 7-8, and 24-35 are presented for appeal.  
Applicants are not appealing the rejection of claims 3-5 and 9.

App. Br. 2.

At no time does the Appellant argue the rejection of claims 3-5 and 9 in the Appeal Brief.

On June 20, 2007, the Examiner mailed an Examiner's Answer, maintaining all the rejections made under 35 U.S.C. § 112, first paragraph,

and 35 U.S.C. § 103(a), while withdrawing the rejection made under 35 U.S.C. § 102(b).

## DISCUSSION

The Board of Patent Appeals and Interferences (Board), in *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf> (BPAI May 14, 2008) (precedential), held that in appeals where rejected claims are expressly withdrawn, or are implicitly withdrawn by not presenting arguments in support of patentability, the Board will remand the application to the Examiner with instructions to cancel the expressly or implicitly withdrawn claims. *See also Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8<sup>th</sup> ed. Rev. 6, Sept. 2007).

Accordingly, it is

ORDERED that the application is remanded to the Examiner to enter a paper canceling claims 3-5 and 9.

Upon entry of the paper, the application should be returned to the Board for the consideration of claims 1-2, 7-8, and 24-35.

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

DMS/clj

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Baker Botts LLP  
910 Louisiana  
Houston, TX 92614